

REMARKS

Claims 1, 8, 20, 27, and 30 have been amended herein. Claims 1-5, 7-8, 10-24 and 26-32 remain pending for consideration.

Reconsideration of the application is respectfully requested in view of the following responsive remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

In the Office Action, the following actions were taken:

(1) Claims 1, 4, 7, 8, 12, 14-16, 18, 20, 23, and 26-32 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pub. No. 20030025321 A1 (hereinafter "Lee").

(2) The Examiner withdrew the 102(a) rejection and the corresponding 103 rejection in light of the Applicant's exhibit and affidavits establishing an invention date prior to February 6, 2006 (Lee's publication date). However, upon reconsideration, the Examiner has now extended the 102(e) rejection to all pending claims in the present application.

It is respectfully submitted that the presently pending claims be examined and allowed.

Rejections Under 35 U.S.C. § 102

The Examiner has rejected claims 1, 4, 7, 8, 12, 14-16, 18, 20, 23, and 26-32 under 35 U.S.C. § 102(e) as being anticipated by Lee. Before discussing the rejection, it is thought proper to briefly state what is required to sustain such a rejection. It is well settled that "[a] claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). In order to establish anticipation under 35 U.S.C. 102, all elements of the claim must be found in a single reference. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986), cert. denied 107 S.Ct. 1606 (1987). In particular, as pointed out by the court in *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1981), cert. denied, 469 U.S. 851 (1984), "anticipation requires that each and every element of the

claimed invention be disclosed in a prior art reference." "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.* 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

The Applicant respectfully submits that each and every element of amended independent claims is not present in Lee. Independent claims 1, 8, 20, 27, and 30 have each been amended to more specifically claim that the data storage device is positioned with respect to only a portion of the print medium. In other words, the storage device must be smaller than the print medium as it is only related to a portion of the print medium. Lee, on the other hand, teaches a magnetic layer that is the same size of the ink receptive layer. See abstract, Figures 1-4. Lee specifically refers to Figure 1, stating that "the magnetic printing media 2 is comprised of three layers: a base layer 6, a magnetic layer 8, and an ink receptive layer 10." See col. 2, lines 38-41. These layers are of equal size and are referred to as the "magnetic printing media" that can be "of any size that can be accommodated by any printer." See Figure 1; and col. 2, lines 42-47. The specification further states that the magnetic media sheet can be read by a magnetic head and that the "encoded information can be read as an entire sheet . . . or in its entirety (i.e., reading the entire page at once)." See col. 4, lines 53-56. Clearly, Lee teaches a magnetic media sheet that contains at least 3 components of the same size, while the present claim set requires the data storage device to be positioned with respect to only a portion of the print medium. The present amendment clarifies this distinction by specifically requiring a smaller data storage device as compared to the print medium, as it is only present on a portion of the print medium. Support for this amendment can be found throughout the specification and as previously listed. Accordingly, the Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 102(e) for the amended independent claims and subsequent dependent claims.

The Applicant submits that as Lee cannot anticipate the current claim set due to a missing element, and as Lee is not available as prior art, per 35 U.S.C. 103(c), the present claim set is believed to be in condition for allowance (see statement provided in the May 1, 2006 office action related to the obligation to assign).

CONCLUSION

In view of the foregoing, it is Applicant's position that the present claim set presents allowable subject matter and allowance thereof is respectfully requested.

Further, all claims that had previously been withdrawn which related to the election of species requirement are believed to now be also allowable, as all independent claims are generic and are in allowable condition. Reconsideration of the election of species requirement is also requested.

If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone W. Bradley Haymond (Registration No. 35,186) at (541) 715-0159 so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025

Dated this 25th day of October, 2006.

Respectfully submitted,



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